REMARKS

This Response is submitted in reply to the Final Office Action dated March 21, 2006. Claims 1, 28, and 39 have been amended. New Claims 68 to 81 have been added. Previously withdrawn Claims 9 to 16, 19 to 27, 29 to 38 and 40 to 67 have been cancelled without prejudice or disclaimer. No new matter has been added by such amendments.

A Request for Continued Examination and a Petition for a One Month Extension of Time to file this Response are submitted herewith. Please charge deposit account number 02-1818 for any fees which are due and owing in connection with this RCE, this Petition and this Response.

The Office Action rejected Claims 1 to 8, 17, 18 and 28 under 35 U.S.C. §103(a) as being unpatentable over Greep (U.S. Patent Application Publication No. 2003/0163125) in view of Edwards et al. (U.S. Patent No. 5,413,788).

Greep discloses an electrosurgical electrode wherein at least a portion of the electrode is coated with an active catalyst and a binder material. An energy source, such as a heat source, a light source, a microwave source, or other electromagnetic radiation or energy source cooperates with the electrosurgical electrode to activate the catalytic particles. The active catalytic particles advance the release of charred blood and/or tissue (i.e., eschar) which accumulates on the electrode during an electrosurgical procedure by interacting with the eschar constituents to reduce chemical absorption and/or bonding. The activated particles react with the carbon or nitrogen based materials in the accumulated eschar. As a result, bonds that have occurred between the eschar and the surface of the electrode are broken, allowing the eschar to release from the electrode.

Edwards discloses an anti-microbial composition for topical use or for incorporation into a coating or structural composition. Specifically, Edwards discloses anti-microbial compositions suitable for application to or impregnation in medical and other appliances. The Office Action states that Edwards discloses an anti-microbial

composition used to provide a sustainable anti-microbial effect without any energy source.

Amended independent Claim 1 is directed to an electrosurgical device including an electrode, a handle connected to the electrode and an electrical source in communication with the handle to transfer electrical energy to the electrode for contacting tissue in a body during an electrosurgical procedure. The electrosurgical device includes an electrically conductive substrate and at least one substantially uniform coating applied to the substrate. The coating includes a cured electrostatically grounded wet base material having a plurality of electrostatically charged dry anti-microbial particles interspersed in the base material and at least in part electrostatically bonded to the base material. The anti-microbial particles are formulated to reduce or kill a plurality of microbial organisms independent of any energy source.

The Office Action states that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the coating of Greep with the coating of Edwards to provide a sustainable anti-microbial coating without the aid of an energy source. Applicant respectfully disagrees and submits that one of ordinary skill in the art would not be motivated to modify the coating of Greep with the coating of Edwards because this would substantially change and destroy the functionality and intended purpose of the Greep electrosurgical device. It is well settled law that the combination of references used to reject a claim cannot ignore the intended purpose of the primary reference, destroy the intended purpose of the primary reference, or change the principle of operation of the primary reference. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984). Additionally, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As described above, Greep discloses an electrosurgical device which requires an energy source to function properly. As further described above, Edwards discloses

an anti-microbial coating which functions without any energy source. Applicant submits that applying a coating which does not require an energy source (Edwards) to an electrosurgical device designed to function with an energy source (Greep) destroys the intended purpose of the electrosurgical device of Greep. Accordingly, Applicant submits that Greep and Edwards are not properly combinable to form the basis of these rejections and such rejections should be withdrawn.

Assuming arguendo that Greep and Edwards are properly combinable, Applicant respectfully submits that neither Greep or Edwards individually, nor the electrosurgical device resulting from the combination of Greep and Edwards discloses, teaches or suggests a coating applied to the substrate, wherein the coating includes a cured electrostatically grounded wet base material having a plurality of electrostatically charged dry anti-microbial particles interspersed in the base material and at least in part electrostatically bonded to the base material. The electrosurgical device of amended independent Claim 1 includes a coating applied to the substrate, wherein the coating includes a cured electrostatically grounded wet base material having a plurality of electrostatically charged dry anti-microbial particles interspersed in the base material and at least in part electrostatically bonded to the base material. Accordingly, Applicant respectfully submits that amended independent Claim 1 is patentably distinguished over Greep in view of Edwards and in condition for allowance.

Claims 2 to 8, 17 and 18 depend directly or indirectly from amended independent Claim 1 and are also allowable for the reasons given with respect to Claim 1, and because of the additional features recited in these claims.

Amended independent Claim 28 is directed to an electrosurgical instrument that includes, amongst other elements, a coating which includes a cured electrostatically grounded wet base material having a plurality of electrostatically charged dry anti-microbial particles interspersed in the base material and at least in part electrostatically bonded to the base material. As described above with respect to amended independent Claim 1, neither Greep or Edwards individually, nor the electrosurgical instrument resulting from the combination of Greep and Edwards discloses, teaches or suggests a coating which includes a cured electrostatically grounded wet base material having a

plurality of electrostatically charged dry anti-microbial particles interspersed in the base material and at least in part electrostatically bonded to the base material. On the other hand, the electrosurgical instrument of amended independent. Accordingly, Applicant respectfully submits that amended independent Claim 28 is patentably distinguished over Greep in view of Edwards and in condition for allowance.

The Office Action rejected Claim 39 under 35 U.S.C. §103(a) as being unpatentable over Greep in view of Edwards and further in view of Greep et al. (U.S. Patent Application Publication No. 2003/0109864).

As described above, Greep discloses an electrosurgical electrode wherein at least a portion of the electrode is coated with an active catalyst. As described above, Edwards discloses anti-microbial compositions suitable for application to or impregnation in medical and other appliances. The Office Action states that Greep et al. discloses a method of partially curing a base material and filler on a substrate. Accordingly, the combination of Greep, Edwards and Greep et al. would result in an electrosurgical electrode wherein at least a portion of the electrode is coated with an anti-microbial composition and the coating is at least partially cured.

Amended independent Claim 39 is directed to a method of coating an electrosurgical device including an electrically conductive substrate which includes evenly applying a substantially uniform coating to a surface of the conductive substrate, the coating including an electrically or electrostatically grounded wet base material and a plurality of anti-microbial particles interspersed in the base material, wherein the anti-microbial particles are formulated to reduce or kill a plurality of microbial organisms independent of any energy source and the anti-microbial particles have an electrical or electrostatic charge opposite the electrical charge of the base material. The method further includes at least partially curing base material and the particles interspersed in the base material.

The Office Action states that it would have been obvious to one of ordinary skill in the art at the time of the invention to add the partial curing method of Greep et al. to the method of Greep in view of Edwards to allow particles to be permanently embedded in the base material. Applicant respectfully submits that regardless of if would have been

obvious to apply the curing method of Greep et al. to the electrode of Greep in view of the coating of Edwards, the electrosurgical instrument resulting from such a combination would not teach, disclose or suggest a coating which includes an electrically or electrostatically grounded wet base material and a plurality of anti-microbial particles interspersed in the base material, wherein the anti-microbial particles have an electrical or electrostatic charge opposite the electrical charge of the base material. That is, neither Greep, Edwards or Greep et al. teach, disclose or suggest electrostatically applying a coating to a conductive substrate. On the other hand, the coating applied in the method of coating an electrosurgical device of amended independent Claim 39 includes an electrically or electrostatically grounded wet base material and a plurality of anti-microbial particles interspersed in the base material, wherein the anti-microbial particles have an electrical or electrostatic charge opposite the electrical charge of the base material. Accordingly, Applicant respectfully submits that amended independent Claim 39 is patentably distinguished over Greep in view of Edwards in further view of Greep et al. and in condition for allowance.

Applicant respectfully submits that new independent Claim 71 includes elements of amended independent Claim 1 and thus the subject matter of new independent Claim 71 has already been considered in connection with amended independent Claim 1. Specifically, new independent Claim 71 is directed to an electrosurgical device including an electrode configured to be attached to a handle which is connectable to an electrical source to transfer electrical energy to the electrode for contacting tissue in a body during an electrosurgical procedure. The electrode includes an electrically conductive substrate, and at least one substantially uniform coating applied to the substrate. The coating includes a cured electrostatically grounded wet base material having a plurality of electrostatically charged dry anti-microbial particles interspersed in the base material and at least in part electrostatically bonded to the base material, wherein the anti-microbial particles are formulated to reduce or kill a plurality of microbial organisms independent of any energy source. For the reasons discussed above and because of the additional features recited in this claim, Applicant respectfully submits that new

Claim 71 (and dependent Claims 72 to 81 which depend either directly or indirectly off of new independent Claim 71) are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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